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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/454,684	12/03/99	PROBST	P 210121.469C4

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JANE E.R. POTTER
INTELLECTUAL PROPERTY LAW GROUP PLLC
6300 COLUMBIA CENTER
701 FIFTH AVENUE
SEATTLE WA 98104-7092

EXAMINER	
BRUNOVSKIS,P	
ART UNIT	PAPER NUMBER
1632	14

DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/454,684	Applicant(s) PROBST ET AL.	
	Examiner Peter Brunovskis	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-66* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, 7-10, 13, 15, 17(a), 18, 20, 22(a), 23-25, and 64-66, drawn to polypeptides and methods of using such, classified in class 530, subclass 350.

II. Claims 3-6, 11, 14, 16, 17(b), 19, 21, 22(b), 23-25, drawn to polynucleotides, classified in class 536, subclass 23.7.

III. Claims 12, 17(c), 22(c), 23-25, 26, drawn to antibodies, classified in class 530, subclass 387.1.

IV. Claims 27-29, 39-44, and 49, drawn to a diagnostic method wherein the binding agent is a protein, classified in class 435, subclass 7.1.

V. Claims 30, 31, 45, and 46, drawn to primers and their use in a diagnostic PCR assay, classified in class 435, subclass 91.2.

VI. Claims 32, 33, 47, and 48, drawn to oligonucleotide probe(s) and their use in a diagnostic hybridization assay, classified in class 435, subclass 6.

VII. Claims 34-38 and 49, drawn to a diagnostic method wherein the binding agent is an antibody, classified in class 435, subclass 7.1.

VIII. Claims 50, 52-57, drawn to a pharmaceutical cell composition comprising T cells proliferated in the presence of a polypeptide and ex vivo administration of said

cells in a method of treating Chlamydial infection, classified in class 424, subclass 93.21.

IX. Claim 51-55, and 58, drawn to a pharmaceutical cell composition comprising T cells proliferated in the presence of a polynucleotide and ex vivo administration of said cells in a method of treating Chlamydial infection, classified in class 424, subclass 93.21.

X. Claims 59, 61, and 62, drawn to a method of treating Chlamydial infection, comprising ex vivo administration of antigen-presenting cells incubated in the presence of a polypeptide, classified in class 424, subclass 93.21.

XI. Claims 60, 61, and 62, drawn to a method of treating Chlamydial infection, comprising ex vivo administration of antigen-presenting cells incubated in the presence of a polynucleotide, classified in class 424, subclass 93.21.

For purposes of restriction, claim 46 is interpreted as depending from claim 45, since there is a lack of antecedent basis relative to claim 43, as recited.

Generic claims 17, 19, 22, 23-26, 52-55, and 59-62 are improperly drawn to multiple dependent claims. MPEP 608.01 (n), part I.C. states:

> "For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim".

Inventions I-XI are each drawn to multiple, patentably distinct sets of inventions, drawn or directed to the use in each case to a separate, patentably distinct polypeptide, polynucleotide, or antibody. The separate members of each independent and distinct polypeptide, polynucleotide, or antibody are not proper species of a genus, since there are no common core structures among members of each generic polypeptide-, polynucleotide or antibody group. Consequently, Applicant is required under 35 U.S.C. 121 to elect a single disclosed SEQ ID NO for prosecution on the merits to which the claims shall be restricted.

Applicant is advised that a reply to this requirement must include an identification of the SEQ ID NO that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. If claims are added after the election, applicant must indicate which are readable upon the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Product inventions of groups I-III, and VIII-XI and method inventions of groups IV-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or comprise different products with different functions and different modes of operation functioning in mechanistically different ways. Inventions I-XI are distinct because the inventions utilize biologically distinct reagents and function in mechanistically different ways. Methods of utilizing independent

patentably distinct polypeptides, polynucleotides, oligonucleotides, antibodies, or cells of the instant invention for therapeutic and/or diagnostic purposes requires different technical considerations, objectives, and modes of action. The differences between Inventions I-VII and inventions VIII-XI are further underscored by their different classification and independent search status.

Invention I and inventions IV, VIII, and X; invention II and inventions V, VI, IX, and XI; and invention III and invention VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of inventions I can be used to make the antibodies of invention III; the polynucleotides of invention II can be used to make the polypeptide of invention I; and the antibody of invention III can be used to immunopurify the polypeptide of invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Groups II-XI, and vice versa, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Brunovskis whose telephone number is (703) 305-2471. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda can be reached at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analyst, Patsy Zimmerman whose telephone number is (703) 308-8338.

Scott D. Priebe

SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER

Peter Brunovskis, Ph.D.
Patent Examiner
Art Unit 1632